Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KESAAKI KITAZAWA
and
SHIGETOSHI TAKASU

Appeal No. 2000-0290
Application No. 08/670,805

ON BRIEF

Before CALVERT, COHEN, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5, 10 and 11, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method for producing a fixation roll used in an electrophotographic apparatus. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 5, 10 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Appellants Admitted Prior Art[1] (hereinafter referred to as AAPA).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the non-final office action (Paper No. 16, mailed August 4, 1998) and the answer (Paper No. 22, mailed June 7, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 21, filed May 24, 1999) and reply brief (Paper No. 23,

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[1] Claim 10 (the only independent claim on appeal) is drafted as a Jepson type claim in which the preamble of the claim is an admission of prior art. Note, In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

filed July 13, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art (i.e., AAPA), and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In accordance with 37 CFR § 1.192(c)(7), we have selected claim 10 as the representative claim from the appellants' grouping of claims 5, 10 and 11 to decide the appeal on the rejection under 35 U.S.C. § 103. See page 2 of the appellants' brief.

Claim 10 reads as follows:

> A method for producing a fixation roll used in an electrophotographic apparatus, said fixation roll comprising an annular wall having a fluorocarbon coating provided on an exterior surface thereof, a longitudinally extending primary bore and a plurality of secondary bores

> surrounding said primary bore and having longitudinal axes parallel to the longitudinal axis of the primary bore provided therein and a heat pipe tightly embedded in each secondary bore, said heat pipe comprising a copper tube having water sealed therein, said method comprising the steps of: providing said annular wall; inserting a heat pipe into each secondary bore, said heat pipe having an outer diameter which is smaller than the inner diameter of the secondary bores and heating the heat pipes to convert the water sealed therein to steam and plastically deforming the heat pipes by the vapor pressure of the steam to be tightly fitted in the bores, wherein the improvement comprises said copper tube being an oxygen-free or phosphorus deoxidized copper tube initially having a temper of 0 or 1/16H and a Vickers hardness in the range of 40 to 90 after plastic deformation by the steam.

The examiner's rejection (Paper No. 16, page 2) is based on AAPA (everything in claim 10 prior to "the improvement comprises") teaching the method essentially as claimed except for the particular material used (everything in claim 10 following "the improvement comprises"). As to this difference, the examiner then determined that the difference is an article consideration "deemed to carry no patentable weight in a claim to a method of manufacture."

The appellants argue (brief, page 4) that the failure of the examiner to give weight to the particular material used

"is clearly erroneous" in that these article limitations more particularly describe the material that is being worked on by the claimed method steps. The appellants then requested the examiner to provide case law permitting the particular material used in a process claim to be ignored. The examiner in the answer maintained the rejection and did not cite any case law in support of her position.

Under 35 U.S.C. § 103 all words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Furthermore, it is well established that the materials on which a process is carried out must be accorded weight in determining the obviousness of that process. See In re Pleuddemann, 910 F.2d 823, 825-28, 15 USPQ2d 1738, 1740-42 (Fed. Cir. 1990); In re Kuehl, 475 F.2d 658, 664-65, 177 USPQ 250, 255 (CCPA 1973); Ex parte Leonard, 187 USPQ 122, 124 (Bd. App. 1974).

In our view, the case law clearly establishes that the position of the examiner in this case is in error. That is,

the particular material recited following the phrase "the improvement comprises" in claim 10 cannot be ignored under 35 U.S.C. § 103. When that material is given weight as required under 35 U.S.C.
§ 103, it is clear that the examiner has not established that the subject matter of claim 10 would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, the decision of the examiner to reject claim 10, and claims 5 and 11 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 5, 10 and 11 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)
IRWIN CHARLES COHEN Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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